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EXAMINER

JOO, JOSHUA

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/990,256	Applicant(s) CHOW, KINGSUM	
	Examiner Joshua Joo	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Office Action filed on 6/15/2005

1. Claims 1-26 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, US Patent #6,654,779 in view of Ueshima, US Patent #6,731,731.

4. As per claim 1, Tsuei teaches substantially the invention as claimed including the system for forwarding electronic mail that is addressed to an old email address to a second email address. Tsuei's teachings comprise of:

a server, within the data communication network, to receive data from a database, to host forwarding searches, and to perform forwarding actions (Col 9, lines 53-54. Sender ISP sends an address query to the E-mail Address Management system (EAMS hereinafter). Col 10, lines 28-33. Sender ISP receives a new address from the EAMS and forwards the email to the user),

a database, in communication with the server within the data communication network, that enters, updates, and maintains source and destination electronic mail addresses for forwarding; wherein the system is adapted to (Col 6, lines 16-24. EAMS is a database system used to correlate an old email address to a new email address. Col 6, lines 31-44. User

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registers his/her address change with the EAMS, and the EAMS maintains a database of the old and new addresses),

receive a registration of an electronic mail account of a user to forward to anew electronic mail address (Col 6, lines 30-33. User registers his/her address change with the EAMS. Col 11, lines 12-16. Registration includes submitting an old email address and a new email address),

receive an electronic mail message from a sender that specifies the user's electronic mail account as a recipient (Col 9, lines 4-6. Sender sends an email that specifies the user's email address. Col 9, line 18, Sender ISP receives the email),

search for the new electronic mail address for the user for forwarding (Col 9, lines 60-64. EAMS searches its database for the new email address); and

forward the electronic mail message to the new electronic mail address (Col 10, lines 30-36. The email is forwarded to the new email address).

5. Tsuei teaches of different types of authentication processes for using the service to change the user's email address in order to provide security for users. The authentication processes involves providing authenticating information such as the user's personal information (Col 10, lines 48-60). However, Tsuei does not teach of sending a confirmation electronic mail with a required password to the user.

6. Ueshima teaches of providing authentication, where it is a well known method of authentication for a registered user of a system to be assigned a password, where the authentication involves inputting a password (Col 1, lines 28-36). Ueshima further teaches that the passwords may be transmitted as an electronic mail to an electronic mail address specified by the user (Col 4, lines 42-45).

7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and Ueshima because the teachings of Ueshima to provide a password in an electronic mail for authentication purposes would improve the security of Tsuei's system by preventing unauthorized access to the system, further protecting the users' email addresses and ensuring that the address changes are valid.

8. As per claim 2, Tsuei teaches the system of claim 1, wherein the data communication network includes at least one of the Internet and an Intranet (Col 4, lines 36-37. Electronic mail operates in an Internet environment. Col 1, lines 46-54. Electronic mail may involve domains such as .gov, .mil, or .edu).

9. As per claim 9, Tsuei teaches the system of claim 1, wherein the sender receives an electronic mail message from the user informing the sender that the sender's electronic mail message was forwarded (Col 7, lines 43-46. Sender ISP notifies the sender via an email of the user's new address).

10. Claims 3, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei and Ueshima in view of MacIntosh et al, US Application #2002/0138581 (MacIntosh hereinafter).

11. As per claim 3, Tsuei does not teach the system of claim 1, wherein the user's electronic email account is disabled after the user registration.

12. MacIntosh teaches of creating an email forwarding address, where a user can manage his/her email address account and has the option to disable any one of the user's email

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forwarding addresses (Paragraph 0007). Furthermore, MacIntosh teaches that a forwarding email addresses can be used for the system instead of the user's personal email address (Paragraph 0075).

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and MacIntosh because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings of MacIntosh to disable an email address would improve the capability of Tsuei's system by allowing the user to terminate an account that might be receiving unwanted email such as spam.

14. As per claim 4, Tsuei teaches of communicating through electronic mail to the user's friends and acquaintances by providing the user's electronic mail address (Col 5, lines 51-60). Tsuei does not teach the system, wherein server forwards an electronic mail address of the sender to the user.

15. MacIntosh teaches that the user can receive an email from a sender and the user can send a reply email back to the sender (Paragraph 0088; 0093).

16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and MacIntosh because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings of MacIntosh to receive the electronic mail address of the sender would improve the functionality of Tsuei's system by allowing the user to respond to mail send by a sender.

17. As per claim 5, Tsuei does not teach the system of claim 4, wherein the user responds to one of the sender directly and to the sender indirectly through the server.

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18. MacIntosh teaches that a user can respond directly and indirectly to the sender through the server by providing an option to mask the user's email address so that sender does not know the user's email address (Paragraph 0093).

19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and MacIntosh because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings of MacIntosh to provide the user an option to reveal the user's email address to the sender would improve the functionality of Tsuei's system by providing greater privacy and protection to the user.

20. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei and Ueshima in view of Quine, US Patent #6,832,246.

21. As per claim 6, Tsuei does not teach the system of claim 1, wherein the user's new electronic mail address is made unavailable to the sender.

22. Quine teaches of electronic mail forwarding where the forwarding system sends an email to the sender indicating that the original addressed electronic mail was forwarded (Col 6, lines 1-3).

23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and Quine because both teachings deal with the forwarding of electronic mail. The teachings of Quine to send an electronic mail to the sender indicating the message was forwarded would improve the user-friendliness of Tsuei's system by allowing the sender to know that sender's electronic mail has reached its destination and it also protects the privacy of the of user's electronic mail address.

24. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei and Ueshima in view of Mulligan et al, US Patent #5,937,161 (Mulligan hereinafter).

25. As per claim 7, Tsuei teaches that if the user's old electronic mail account exists, the electronic mail is send to the user's old electronic mail account (Col 9, lines 31-34). If the old electronic mail does not exist, then the a new address is searched (Col 9, lines 60-64).

However, Tsuei does not teach the system, wherein the electronic mail message from the sender is forwarded to the user's electronic mail account, if the new electronic mail address is not found.

26. Mulligan teaches of electronic message forwarding, where if there is no match for forwarding the electronic mail, it is forwarded to the user-specified address (Col 7, lines 20-25).

27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and Mulligan because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings Mulligan to forward the electronic mail to the user's mail account if there is no forwarding information would improve the reliability of Tsuei's system by allowing the user to receive the electronic mail even if the database might not available, and Mulligan's teachings would ensure that the user will receive the electronic mail.

28. As per claim 8, Tseui teaches the system of claim 7, wherein the sender receives an electronic mail message indicating that the sender's electronic mail message is undeliverable if the user's electronic mail account is no longer reachable (Col 10, lines 7-11. Sender ISP notifies the sender via an email that the message could not be delivered to the provided address).

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29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and Mulligan because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings Tsuei to notify the sender if the electronic mail could not be delivered would improve the user-friendliness of Tsuei's system because the notification will allow the sender to not unknowingly and repeatedly send electronic messages to an account that cannot be reached.

30. Claims 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei in view of Ueshima, Mulligan, and MacIntosh.

31. As per claim 10, Tsuei teaches substantially the invention as claimed including the system for forwarding electronic mail that is addressed to an old email address to a second email address. Tsuei's teachings are implemented as one or more computer application programs, operative to run on a computer apparatus (Col 8, lines 51-54). Tsuei's teachings comprise of:

receive a registration of an electronic mail account of a user to forward to a new electronic mail address (Col 6, lines 30-33. User registers his/her address change with the EAMS. Col 11, lines 12-16. Registration includes submitting an old email address and a new email address),

receive an electronic mail message from a sender that indicates the user's electronic mail account as a recipient (Col 9, lines 4-6. Sender sends an email that specifies the recipient's email address. Col 9, line 18, Sender ISP receives the email),

search a database for the new electronic mail address of the user for forwarding (Col 9, lines 60-64. EAMS searches its database for the new email address),

forwarding the electronic mail message to the new electronic mail address (Col 10, lines 30-37. The email is forwarded to the new email address),

send an electronic mail message to the sender indicating that the sender's electronic mail message to user is undeliverable (Col 10, lines 7-11. Sender ISP notifies the sender via an email that the message could not be delivered to the provided address).

32. Tsuei teaches of different types of authentication processes for using the service to change the user's email address in order to provide security for users. The authentication processes involves providing authenticating information such as the user's personal information (Col 10, lines 48-60). However, Tsuei does not teach of sending a confirmation electronic mail with a required password to the user.

33. Ueshima teaches of providing authentication, where it is a well known method of authentication for a registered user of a system to be assigned a password, where the authentication involves inputting a password (Col 1, lines 28-36). Ueshima further teaches that the passwords may be transmitted as an electronic mail to an electronic mail address specified by the user (Col 4, lines 42-45).

34. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and Ueshima because the teachings of Ueshima to provide a password in an electronic mail for authentication purposes would improve the security of Tsuei's invention by preventing unauthorized access to the system, further protecting the users' email addresses and ensuring that the address changes are valid.

35. Tsuei teaches that if the user's old electronic mail account exists, the electronic mail is send to the user's old electronic mail account (Col 9, lines 31-34). If the old electronic mail does

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not exist, then a new address is searched (Col 9, lines 60-64). However, Tsuei does not teach the system, wherein the electronic mail message from the sender is forwarded to the user's electronic mail account, if the new electronic mail address is not found.

36. Mulligan teaches of electronic message forwarding, where if there is no match for forwarding the electronic mail, it is forwarded to the user-specified address (Col 7, lines 20-25).

37. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and Mulligan because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings Mulligan to forward the electronic mail to the user's mail account if there is no forwarding information would improve reliability of Tsuei's system by allowing the user to receive the electronic mail even if the database might not be available, and Mulligan's teachings would ensure that the user will receive the electronic mail.

38. Tsuei does not teach the system, wherein server forwards an electronic mail address of the sender to the user.

39. MacIntosh teaches that the user can receive an email from a sender and the user can send a reply email to the sender (Paragraph 0088; 0093).

40. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and MacIntosh because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings of MacIntosh to receive the electronic mail address of the sender would improve the functionality of Tsuei's system by preventing the receipt of anonymous electronic mail and allowing the user's to respond to incoming mail.

41. As per claim 11, Tsuei teaches the system of claim 10, wherein the instructions are provided to a server to host forwarding searches and to execute forwarding actions (Col 9, lines 53-54. Sender ISP sends an address query to the EAMS. Col 10, lines 28-33. Sender ISP receives a new address from the EAMS and forwards the email to the user).

42. As per claim 12, Tsuei teaches the system of claim 10, wherein the instructions are provided to a database to input, monitor, and update an electronic mail address for forwarding (Col 6, lines 16-24. EAMS is a database system used to correlate an old email address to a new email address. Col 6, lines 31-44. User registers his/her address change with the EAMS, and the EAMS maintains a database of the old and new addresses).

43. As per claims 13, Tsuei does not teach the system of claim 12, wherein the user's electronic email account is disabled after the database receives instructions to input the electronic mail account.

44. MacIntosh teaches of creating an email forwarding address, where a user creates email address with a service and has the option to disable any of the email forwarding addresses (Paragraph 0007). Furthermore, MacIntosh teaches that a forwarding email addresses can be used instead of the user's personal email address (Paragraph 0075).

45. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and MacIntosh because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings of MacIntosh to disable an email

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address would improve the capability of Tsuei's system by allowing the user to terminate an account that might be receiving unwanted email such as spam.

46. As per claims 14 and 15, Tsuei does not teach the system, wherein the user responds to one of the sender directly and to the sender's electronic mail address indirectly through the server.

47. MacIntosh teaches that a user can respond directly and indirectly to the sender through the server by providing an option to mask the user's email address so that sender does not know the user's email address (Paragraph 0093).

48. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and MacIntosh because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings of MacIntosh to provide the user an option to reveal the user's email address to the sender would improve the functionality of Tsuei's system by providing greater privacy and protection to the user.

49. As per claim 16, Tsuei teaches the system of 10, wherein the sender is informed that the electronic mail message of the sender has been delivered to the new electronic mail address of the user (Col 7, lines 43-46. Sender ISP notifies the sender via an email of the user's new address).

50. Claims 17-20, 22, 23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei in view of Mulligan and MacIntosh.

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51. As per claim 17, Tsuei teaches substantially the invention as claimed including the method for forwarding electronic mail that is addressed to an old email address to a second email address. Tsuei's teachings comprise of:

a receiving a registration of an electronic mail account of a user to forward to a new electronic mail address (Col 6, lines 30-33. User registers his/her address change with the EAMS. Col 11, lines 12-16. Registration includes submitting an old email address and a new email address),

receiving an electronic mail message from a sender that specifies the user's electronic mail account as a recipient (Col 9, lines 4-6. Sender sends an email that specifies the recipient's email address. Col 9, line 18, Sender ISP receives the email),

searching for the new electronic mail address of the user for forwarding (Col 9, lines 60-64. EAMS searches its database for the new email address);

forwarding the electronic mail message to the new electronic mail address (Col 10, lines 30-37. The email is forwarded to the new email address),

sending an electronic mail message to the sender indicating that the sender's electronic mail message to user is undeliverable (Col 10, lines 7-11. Sender ISP notifies the sender via an email that the message could not be delivered to the provided address).

52. Tsuei teaches of communicating through electronic mail to the user's friends and acquaintances by providing the user's electronic mail address (Col 5, lines 51-60). However, Tsuei does not teach the system, wherein server forwards an electronic mail address of the sender to the user.

53. MacIntosh teaches that the user can receive an email from a sender and the user can send a reply email to the sender (Paragraph 0088; 0093).

54. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and MacIntosh because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings of MacIntosh to receive the electronic mail address of the sender would improve the functionality of Tsuei's system by preventing the receipt of anonymous electronic mail and allowing the user's to respond to incoming mail.

55. Tsuei teaches that if the user's old electronic mail account exists, the electronic mail is send to the user's old electronic mail account (Col 9, lines 31-34). If the old electronic mail does not exist, then the a new address is searched (Col 9, lines 60-64). However, Tsuei does not teach the system, wherein the electronic mail message from the sender is forwarded to the user's electronic mail account, if the new electronic mail address is not found.

56. Mulligan teaches of electronic message forwarding, where if there is no match for forwarding the electronic mail, it is forwarded to the user-specified address (Col 7, lines 20-25).

57. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and Mulligan because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings Mulligan to forward the electronic mail to the user's mail account if there is no forwarding information would improve the reliability of Tsuei's system by allowing the user to receive the electronic mail even if the database might not be available, and Mulligan's teachings would ensure that the user will receive the electronic mail..

58. As per claim 18, Tsuei teaches the system of claims 17, wherein the data communication network includes at least one of the Internet and an Intranet (Col 4, lines 36-37).

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Electronic mail operates in an internet environment. Col 1, lines 46-54. Electronic mail may involve domains such as .gov, .mil, or .edu).

59. As per claim 19, Tsuei teaches the method of 17, wherein a server, having circuitry to receive data from a database, performs forwarding searches and provides forwarding actions (Col 9, lines 53-54. Sender ISP sends an address query to the EAMS. Col 10, lines 28-33. Sender ISP receives a new address from the EAMS and forwards the email to the user. Col 8, line 64-65. A computer system is associated with the sender ISP and the EAMS).

60. As per claim 20, Tsuei teaches the method claim 19, wherein the database enters, updates, and maintains electronic mail address for forwarding (Col 6, lines 16-24. EAMS is a database system used to correlate an old email address to a new email address. Col 6, lines 31-44. User registers his/her address change with the EAMS, and the EAMS maintains a database of the old and new addresses).

61. As per claim 22, Tsuei does not teach the system of claim 17, wherein the user's electronic email account is disabled after the user registration.

62. MacIntosh teaches of creating an email forwarding address, where a user can manage his/her email address account and has the option to disable any of the email forwarding addresses (Paragraph 0007). Furthermore, MacIntosh teaches that a forwarding email addresses can be used instead of the user's personal email address (Paragraph 0075).

63. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and MacIntosh because both teachings deal with the

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forwarding of electronic mail. Furthermore, the teachings of MacIntosh to disable an email address would improve the capability of Tsuei's system by allowing the user to terminate an account that might be receiving unwanted email such as spam.

64. As per claim 23, Tsuei does not teach the method of claim 19, wherein the user responds to one of the sender directly and to the sender indirectly through the server.

65. MacIntosh teaches that a user can respond directly and indirectly to the sender through the server by providing an option to mask the user's email address so that sender does not know the user's email address (Paragraph 0093).

66. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and MacIntosh because both teachings deal with the forwarding of electronic mail. Furthermore, the teachings of MacIntosh to provide the user an option to send the user's email address to the sender would improve the functionality of Tsuei's invention by providing greater privacy and protection to the user.

67. As per claim 25, Tsuei teaches the system of claims 17, wherein the sender receives an electronic mail message from the user informing the sender that the sender's electronic mail message was forwarded (Col 7, lines 43-46. Sender ISP notifies the sender via an email of the user's new address).

68. As per claim 26, Tsuei teaches the method of claim 19, wherein the sender receives an electronic mail message from a server that informs the sender that the sender's electronic mail

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message was forwarded to the user (Col 7, lines 43-46. Sender ISP notifies the sender via an email of the user's new address).

69. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, Mulligan, MacIntosh in view of Ueshima.

70. As per claim 21, Tsuei teaches various types of authentication processes for changing the address such as providing the consumer's personal information to provide security for the user (Col 10, lines 48-60). However, Tsuei does not teach of a confirmation electronic mail with a password is sent to the user after user registration.

71. Ueshima teaches of providing authentication, where Ueshima teaches that it is a well known method of authentication for a registered user of a system to be assigned a password, where authentication involves inputting a password (Col 1, lines 28-36). Ueshima further teaches that the passwords may be transmitted as an electronic mail to an electronic mail address specified by the user (Col 4, lines 42-45).

72. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and Ueshima because the teachings of Ueshima to provide a password in an electronic mail for authentication purposes would improve the security of Tsuei's system by preventing unauthorized access to the system, further protecting the users' email addresses and ensuring that the address changes are valid.

73. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, Mulligan, MacIntosh in view of Quine.

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74. As per claim 24, Tsuei does not teach the system of claim 17, wherein the user's new electronic mail address is made unavailable to the sender.

75. Quine teaches of electronic mail forwarding where the forwarding system sends an email to the sender indicating that the original addressed electronic mail was forwarded (Col 6, lines 1-3).

76. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tsuei and Quine because both teachings deal with the forwarding of electronic mail. The teachings of Quine to send an electronic mail to the sender indicating the message was forwarded would improve the user-friendliness of Tsuei's teachings by allowing the sender to know that sender's electronic mail has reached its destination and it also protects the privacy of the of user's electronic mail address.

Response to Arguments

77. Applicant argued (1) Tsuei does not teach or suggest at least the following elements: "receive an electronic mail message from a sender that specifies the user's electronic mail account as a recipient;" and "forward the electronic the electronic mail message to the new electronic mail address."; (2) Tsuei's E-mail Address Management System (EAMS) does not "receive an electronic mail message from a sender that specifies the user's electronic mail account as a recipient."... Instead the EAMS receives a query from the sender's ISP to inquire as to whether a forwarding address has been registered with the EAMS; (3) The password that is transmitted to the user of service in Ueshima is for registering a telephone, not an email forwarding address; (4) Tsuei's EAMS and Mulligan does not teach or suggest to "dispatch the electronic mail message to the user's electronic mail account, if the new electronic mail address

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is not found.”; and (5) MacIntosh does not teach to “make available an electronic mail address of the sender to the user.”

Examiner traverse the arguments:

78. As to point (1), Tsuei teaches:

- i) Column 9, lines 4-6, “a sender composes a message at his or her computer and address it to the address believed to be correct for an intended recipient. The sender then sends the message from his computer to a computer system that provides Internet access...”
- ii) Column 9, line 18. “the message arrives at the sender ISP
- iii) Column 10, lines 32-33. “Sender ISP forwards the message to the intended recipient's new ISP using the new address.”

Therefore, the above quoted sections from the Tsuei reference clearly shows that Tsuei teaches of Applicant's arguments. Sections i and ii teach of receiving an electronic mail message from a sender that specifies the user's electronic as a recipient as argued by Applicant, and section iii teaches of forwarding the electronic the electronic mail message to the new electronic mail address.”

79. As to point (2), sender ISP receives the electronic mail message from a sender that specifies the user's electronic mail account as a recipient as described above in response to argument of point (1). The EAMS is a database that correlates the old address with the forwarding address (Fig. 3, #340). In Applicant's drawings, Fig. 1 #160 and Fig. 2 #240. Applicant's drawing also clearly shows that a database is used to correlate the old address with the forwarding address, thus the server inquires the database as to whether there is a

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forwarding address. Figure 2 #240 even states "Is a forwarding address found by the database 160?"

80. As to point (3), even though Ueshima teaches of providing authentication specifically for a telephone, Ueshima teaches in the "Background Technique" that the technique for authenticating a person who has preliminarily been registered as a regular user is used in various situations in the society. Thus, Ueshima acknowledges that authentication is widely used in society and may not be strictly limited to just telephones, but for registered users of a system. As in the case with Tsuei, Tsuei teaches of users registering to use the email forwarding system (Col 11, lines 10-16) and providing a consumer authenticator. Therefore, the concept to "send a confirmation electronic mail with a required password to the user", taught by Ueshima in column 4, lines 42-45, may be applied to the teachings of Ueshima in order for a user of Tsuei's system to authenticate his/herself to use the system.

81. As to point (4), even though Applicant further argued that the user-specified default delivery address is not the user's electronic mail account, Mulligan teaches of forwarding email to a user-specified default delivery address (Col 7, lines 21-25). This would imply that the user specified default delivery address may be any address specified by the user, including the user's electronic mail account. Thus Mulligan teachings indicate that the email is send to the user's electronic mail account as claimed in claim 10.

82. As to point (5), MacIntosh teaches that a user sends a reply email (Paragraph 0093), thus an email address is made available to the user. Applicant argues that since the email address is a coded reply address, which is converted to the original email address, the coded

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reply address is not the electronic mail address of the sender. However, the coded email address can be considered as the sender's address, as sending a reply email address by the user allows the sender to receive the user's email without the user having to modify or change the sender's address.

Conclusion

83. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

84. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Friday 7 to 4.

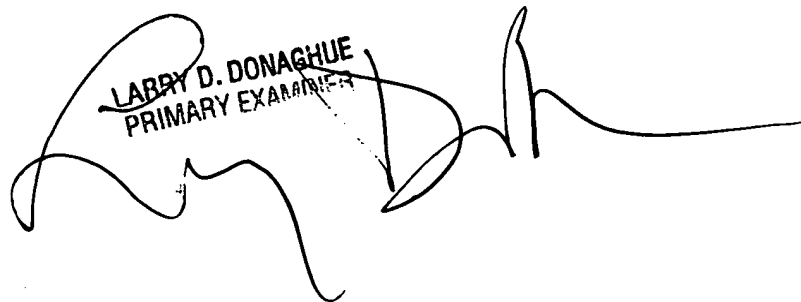
85. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on 571 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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86. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 15, 2005

JJ


LARRY D. DONAGHUE
PRIMARY EXAMINER